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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,226	06/20/2003	Robert F. Burkholder	PTG 02-96-3	9184

23531 7590 01/25/2006

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EXAMINER
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FREAY, CHARLES GRANT

ART UNIT	PAPER NUMBER
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3746

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/601,226	<b>Applicant(s)</b> BURKHOLDER ET AL.	
	<b>Examiner</b> Charles G. Freay	<b>Art Unit</b> 3746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 3-7, 10, 12, 22, 24 and 27-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8, 9, 11, 13-21, 23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of the species shown in Fig. 1 with a plastic shroud and a metal tank in the reply filed on February 17, 2006 is acknowledged.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first access port being an upper open end of a centrally hollow conduit positioned inside the air tank must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is vague and indefinite because it sets forth that the first access port is located on a top wall of the tank (Fig. 4). However, the claim is dependant upon claim 14 which sets forth that the first access port both supplies air to and releases air from the tank (Fig. 4A). The embodiment which discloses air entering through the top of the tank does not disclose this access port both supplying and releasing air from the tank.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 11, 13, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson et al (USPN 5,300,178).

Nelson et al discloses a portable (Figs. 1 and 2) air compressor and a tank (22 see col. 6 lines 18-22) enclosed within a shroud (40) which is made of plastic (note the discussions of the materials for the different embodiments set forth in columns 7 and 8).

With regards to the limitation of the tank having an unpainted outer surface during a manufacturing process the examiner notes that the past condition of a structural element does not limit the finally claimed structure. Further, the examiner notes that this condition is met by any tank which has been painted. Since painting is part of a manufacturing process the tank would have an unpainted surface before it was painted and thus meet the claimed limitation. *This interpretation of the "unpainted outer surface" limitation is applied throughout all of the following rejections.*

Claims 1, 2, 13, 17, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Stenge et al (USPN 5,328,096).

Stenge et al discloses a portable (note the cart of Fig. 1) air compressor (18) and a tank (20) enclosed within a shroud (14). The tank has first and second air access ports located on it's top surface.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stenge et al.

As set forth above Stenge et al disclose the invention substantially as claimed but do not disclose the air access port both supplying and discharging air to the tank. The examiner gives official notice that air tanks having a single access port, with the associated valving being outside the tank, are well known. At the time of the invention it would have been obvious to one of ordinary skill in the art to substitute such single port arrangement for the two port arrangement of the tank shown in Stenge et al in order to reduce the tubing required and also the number of air access ports provided in the tank.

Claims 8, 9, 15, 16, 18, 19, and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Stenge et al as applied to claims 1, 13 and 14 above, and further in view of Moynihan et al (USPN 4,712,983).

As set forth in the above rejection Stenge et al discloses the invention substantially as claimed but does not disclose first and second air access ports located at top and bottom ends of the tank and the tank being made of metal or steel. Moynihan discloses an air compressor (22) and air tank (80) arrange (see Fig. 2) having first (70) and second (90) air access ports for the tank. At the time of the invention it would have been obvious to one of ordinary skill in the art to substitute an air tank having the ports arranged at opposite ends of the tank as disclosed by Moynihan in order to create, and dependant upon, the required spacing in the cart and the desired connection location for the outlet of the air tank. For example, a vertically arranged air tank would allow for a shorter arrangement.

Additionally, Stenge et al do not disclose that the tank is made of metal or steel. Stenge et al at col. 3 lines 29 and 30 discloses that the elements of the invention can be made of steel (a metal). Therefore and the time of the invention it would have been obvious to one of ordinary skill in the art to make the tank of steel as a well known durable and relatively cheap material.

Claims 8, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al in view of Spohrer (USPN 1,998,338).

As set forth above Nelson et al disclose the invention substantially as claimed. Nelson et al do not however disclose that the tank is made of metal or steel. Spohrer discloses an air compressor (46,460) and tank (1) arrangement. As set forth at col. 1 lines 42-45 the tank is made of metal. At the time of the invention it would have been obvious to make the storage tank discussed in Nelson et al of metal or steel (a well known metal) since as taught by Spohrer making the air tank of steel was well known in air compressor arrangements and would provide a durable air storage tank.

Claims 13, 15-19, 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krentz et al (USPN 6,094,773) in view of Moynihan.

Krentz et al discloses a portable air compressor (18) arrangement having a plastic shroud (note lines 1-5 of col. 6) which has a carrying handle (64) and a control panel (46). Krentz et al does not disclose an air tank with the associated porting (as set forth in claims 15-19). As noted earlier Moynihan discloses an air compressor arrangement having a metal air storage tank having two air access ports. At the time of the invention it would have been obvious to one of ordinary skill in the art to supply an air tank having the ports arranged at opposite ends of the tank as disclosed by Moynihan in order to create, and dependant upon, the required spacing in the cart and the desired connection location for the outlet of the air tank. For example, a vertically arranged air tank would allow for a shorter arrangement.



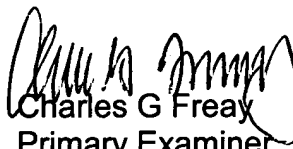
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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles G. Freay whose telephone number is 571-272-4827. The examiner can normally be reached on Monday through Friday 8:30 A.M. to 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Thorpe can be reached on 571-272-4444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Charles G Freay  
Primary Examiner  
Art Unit 3746

CGF  
April 3, 2006